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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,165	07/02/2001	Peter Daute	H3722PCT/US	3060
23657	7590	04/26/2006	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,165

Applicant(s)

DAUTE ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8,9,11 and 15-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,8,9,11 and 15-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 2/17/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21 and 24, which each ultimately depend on claim 15, each recite that the process further comprises "impregnating the granules with additional active substance" while claim 15 has been amended to recite "consisting essentially of" language with respect to the granules. Thus, the scope of each of claim 21 and claim 24 is confusing given that it is not clear how the granules which are limited to "consisting essentially of" component selected from the group consisting of calcium soap, zinc soap, and mixtures thereof can further comprise active substance. That is, given that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel

characteristics of the claimed invention, it is not clear how the granules can further comprise active substance which would materially affect the basic and novel characteristics of the granule.

Claim Rejections - 35 USC § 102

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 6, 8-9, 11, 15-20, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Semen (U.S. 2005/0006627).

The rejection is adequately set forth in paragraph 4 of the office action mailed 10/26/05 and is incorporated here by reference.

Further, with respect to newly added claims 26-28, it is noted that granular composition is added to thermoplastic composition comprising polymer such as polyvinyl chloride.

Additionally, it is noted that the present claims have been amended to recite “consisting essentially of” transitional language with respect to the granules. While it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. sterically hindered phenol antioxidant, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03.

With respect to claims 15-20, it is noted that there is no disclosure in Semen of how the granular composition is made. That is, while Semen discloses spherical granules, there is no disclosure that these spherical granules are made by providing cylindrical granules which were produced in a twin screw extruder at certain temperature and pressure conditions followed by spheronizing the cylindrical granules using spheronizer with certain rotational speed and residence time. However, it is noted that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself”. See MPEP 2113.

Thus, although Semen does not disclose the specific presently claimed process conditions, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, absent evidence of criticality regarding the presently claimed process to make the granular composition and given that Semen meets the requirements of the claimed granular composition, i.e. composition comprising spherical granules of zinc or calcium salts, Semen and clearly meets the requirements of present claims 15-20.

6. Claims 6, 8-9, 11, and 15-28 rejected under 35 U.S.C. 102(b) as being anticipated by Rieber et al. (U.S. 4,235,794).

Rieber et al. disclose composition comprising granules of zinc or calcium salts wherein the granules have diameter of 1-1.5 mm and are spherical. It is noted that Rieber et al. disclose pure metal soap granulate. There is further disclosed method wherein the granular composition is added to thermoplastic composition comprising polymer such as polyvinyl chloride (col.1, lines 6-12, col.2, lines 30-31 and 52-54, col.3, lines 13-16 and 37-38, col.4, lines 37-44, col.7, lines 10-12 and 22-24, and col.11, lines 46-49).

With respect to claims 15-24 and 27, it is noted that there is no disclosure in Rieber et al. of how the granular composition is made. That is, while Rieber et al. discloses spherical granules, there is no disclosure that these spherical granules are made by providing cylindrical granules which were produced in a twin screw extruder at certain temperature and pressure conditions followed by spheronizing the cylindrical granules using spheronizer with certain rotational speed and residence time followed further by impregnating the granules with an additional active substance via surface powdering. However, it is noted that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself”. See MPEP 2113.

Thus, although Rieber et al. do not disclose the specific presently claimed process conditions, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, absent evidence of criticality regarding the presently claimed process to make the granular composition and given that Rieber et al. meet the requirements of the claimed granular composition, i.e. composition comprising spherical granules of zinc or calcium salts that further comprise active substance such as lubricant, Rieber et al. clearly meet the requirements of present claims 15-24 and 27.

In light of the above, it is clear that Rieber et al. anticipate the present claims.

Response to Arguments

7. Applicants’ arguments regarding Carduck et al. (U.S. 5,318,733) and Bergmann (U.S. 5,723,522) have been fully considered but they are moot in view of the discontinuation of the use of these references against the present claims.

8. Applicants’ arguments filed 2/17/06 have been fully considered but, with the exception of arguments relating to Carduck et al. and Bergmann, they are not persuasive.

Specifically, applicants argue that Semen is not a relevant reference against the present claims in light of applicants’ amendment to the present claims which now require “consisting essentially of” claims language with respect to the granules.

However, while it is recognized that the phrase “consisting essentially of” narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. sterically hindered phenol antioxidant, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention, See MPEP 2111.03.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pietralla et al. (U.S. 4,294,771) disclose granulate of calcium salt possessing diameter of 0.2-2 mm, however, there is no disclosure that the granulate is substantially spherical as presently claimed.

Worshech et al. (U.S. 4,591,452) disclose granule of calcium salt possessing diameter of 0.1-1 mm that is added to polyvinyl chloride, however, there is no disclosure that the granule is substantially spherical as presently claimed.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
2/25/06